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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/672,287	09/28/2000	Keiko Matsubara	40589/DBP/Y35	8798

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CHRISTIE, PARKER & HALE, LLP
350 WEST COLORADO BOULEVARD
SUITE 500
PASADENA, CA 91105

EXAMINER

YUAN, DAH WEI D

ART UNIT	PAPER NUMBER
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1745

DATE MAILED: 02/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/672,287

Applicant(s)

MATSUBARA ET AL.

Examiner

Dah-Wei D. Yuan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-11 and 13-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9-11 and 13-15 is/are allowed.
- 6) ☒ Claim(s) 1-4,6-8 and 16-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 19.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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**NEGATIVE ACTIVE MATERIAL FOR RECHARGEABLE LITHIUM BATTERY
ELECTRODE FOR RECHARGEABLE LITHIUM BATTERY, AND METHOD OF
PREPARING NEGATIVE ACTIVE MATERIAL FOR RECHARGEABLE LITHIUM
SECONDARY BATTERY**

Examiner: Yuan

S.N. 09/672,287

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December 23, 2003

Detailed Action

1. The Applicant's amendment filed on November 3, 2003 was received. Claim 1 was amended. Claims 16-20 were added.
2. The text of those sections of Title 35, U.S.C. code not included in this action can be found in the prior Office Action (Paper No. 16).

Claim Rejections - 35 USC § 102

3. The claim rejections under 35 U.S.C. 102(b) as anticipated by Goda et al. on claims 1-4,7,8 are withdrawn, because the independent claim 1 has been amended.
4. Claims 1-4,6-8,16-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Igawa et al. (JP 10-21913).

Igawa et al. teach a secondary lithium battery comprising a positive electrode, a negative electrode and a non-aqueous electrolyte, wherein the negative electrode is produced by coating the surface of a carbon-based material with an amorphous oxide containing one or more elements selected from Li, Ge, Sn, Pb, Sb, Bi, B, Al, Si and In. The weight ratio of the oxide to the

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carbon-based material is preferably in the range of 80/20 to 20/80. See Abstract; Claim2; Paragraph 9.

With respect to claim 4, Igawa et al. do not specifically disclose the particle size of the negative active material. However, it is the position of the examiner that such properties are inherent, given that both Igawa et al. and the present application utilize similar processing technique. A reference which is silent about a claimed invention's features is inherently anticipatory if the missing feature *is necessarily present in that which is described in the reference*. In re Robertson, 49 USPQ2d 1949 (1999).

With respect to claims 6,19, both SnO and SnO₂ are used as the amorphous metal oxides, respectively, in the negative electrode. See Table 1.

Allowable Subject Matter

5. Claims 9-11,13-15 are allowed. Claims 9-11,13-15 are allowable because the closest prior arts of record, Goda et al. and Yoneda et al., do not disclose or suggest the use of a fatty acid metal salt in the preparation of a negative active material for a rechargeable lithium battery, in which the fatty acid metal salt includes one or more metals selected from the group consisting of Sn, Ag, Fe, Pd, Pb, Al, Si, In, Ni, Co, Zn and Cd.

Response to Arguments

6. Applicant's arguments filed on November 3, 2003 have been fully considered but they are not persuasive.

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Applicant's principle arguments are

Goda et al. do not teach the presence of an amorphous metal compound in an amount of 30% wt. or less in the negative active material.

In response to Applicant's arguments, please consider the following comments.

Applicants' arguments are persuasive, however, new grounds of rejection are made based on the newly submitted information disclosure statement.

Conclusion

7. Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on December 11, 2003 prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609(B)(2)(i). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dah-Wei D. Yuan whose telephone number is (703) 308-0766. The examiner can normally be reached on Monday-Friday (8:00-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick J. Ryan, can be reached on (703) 308-2383. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Dah-Wei D. Yuan
December 23, 2003


CAROL CHANEY
PRIMARY EXAMINER